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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TRAN, HAI V	

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/661,164	KIKINIS ET AL.	
	Examiner	Art Unit	
	Hai Tran	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment.. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 06/13/2006 have been fully considered but they are not persuasive.

Claims 1, 11, 20, 26 and 36, Applicant argues, "Reynolds discloses a single broadcast signal that includes both a video component and a generic meta data component; ... This is very different from a 1st broadcast stream and a separate 2nd media. Accordingly, claims 1, 11, 20, 26 and 36 are not anticipated by Reynolds."

In response, the Examiner respectfully disagrees with Applicant because Reynolds clearly discloses the claimed limitation in which the receiver receives both the 1st broadcast stream 110 which includes 112 and 114 having a priority indicator associated with the 1st broadcast stream, i.e., 114 having a priority level associate with it (see § 0031-0032) and a separate 2nd media 142 having a 2nd priority indicator, the receiver permitting automatic insertion of the 2nd media into the 1st broadcast stream based on a comparison of the 1st priority indicator and the 2nd priority indicator (see § 0033-0037). Furthermore, Applicant does not explain how Applicant' s 1st broadcast stream and the separate 2nd media are different from Reynolds 's disclosure but merely states "This is very different from a 1st broadcast stream and a separate 2nd media". In view of that the Examiner maintains the rejection.

Accordingly, claims 8, 7 and 32 are also obvious by Reynolds in view of Bullock, as discussed in the previous Office action.

Applicant's failure to adequately traverse facts officially noticed in the rejections of claims 6 and 16 of the previous Office Action is taken as an admission of the fact(s) noticed.

To adequately traverse the Examiner 's assertion of Official Notice, an applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well known in the art. See 37 CFR 1.111(b). This standard to be applied by the Examiner evaluating the applicant's response should be liberally interpreted, almost any reference to the taking of Official Notice should be taken as sufficient to constitute a proper traverse. Unless the traverse is clearly inadequate, the Examiner should provide a reference for the fact(s) officially noticed in the last Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-5, 7, 9-15, 18-31, and 33-36 are rejected under 35 U.S.C. 102(e) as being unpatentable by Reynolds et al. (US 2001/0037500).

Claim 1, Reynolds discloses a system (Fig. 1) comprising:

A receiver (60; Fig. 1) to receive a 1st broadcast stream (§0025; signal 110) having a 1st priority indicator (114, Fig. 2 and §0032-0037) associated with the 1st broadcast stream (§0025) and

The receiver receiving a separate 2nd media (142, Fig. 2; §0030) having a 2nd priority indicator (§0037), the receiver permitting automatic insertion of the 2nd media or an indication of the 2nd media into an audio or visual presentation (i.e., program stream) of 1st broadcast stream based on a comparison of the 1st priority indicator and the 2nd priority indicator (§0037); the automatic insertion or the indication preserving content of the 1st broadcast stream (program stream not lost, merged with 2nd media and transmitted; §0018 and 0043).

Claim 2, Reynolds further discloses wherein the 1st and 2nd priority indicators comprise numbers (§0037);

Claim 3, Reynolds further discloses wherein the 2nd media and the 1st broadcast stream are the same media (they are both electrical signal, digital data, etc...).

Claim 4, Reynolds further discloses wherein the 2nd media and the 1st broadcast stream are different media (Channel TV data vs. TV program).

Claim 5, Reynolds further discloses wherein an event triggers the 2nd media insertion into the 1st broadcast stream (priority of local metadata higher than generic metadata, as discussed).

Claim 7, Reynolds inherently must have a Sync signal (time mark) within broadcast stream so the system able to synchronize the insertion of the 2nd media insertion with the broadcast stream (§0041 and 0043).

Claim 9, Reynolds further discloses wherein the 1st and 2nd priority indicators are assigned to the 2nd media by a user of the system (local affiliate operator or who ever sets the priorities is a "user" of the system).

Claim 10, Reynolds further discloses wherein the receiver is part of a TV system (see Fig. 1).

Claim 11 is analyzed with respect to claim 1.

Claim 12 is analyzed with respect to claim 2.

Claim 13 is analyzed with respect to claim 3.

Claim 14 is analyzed with respect to claim 4.

Claim 15 is analyzed with respect to claim 5.

Claim 18, Reynolds further discloses wherein the broadcaster may assign a plurality of additional priority indicators to different segments of the 1st broadcast stream based on a subdivision or geographic area, the additional plurality of priority indicators allowing broadcasters to sell advertising space for particular subdivision or geographic area (§0038 and 0028).

Claim 19 is analyzed with respect to claim 7.

Claim 26 is further analyzer with respect to claim 1 in which "a machine readable storage medium tangibly embodying a sequence of instructions executable by the machine to perform a method for inserting media into a broadcast stream" is inherently met by Reynolds because Reynolds shows a system with CPU and memory in which a software must exist in order to perform the function as described.

Claim 27 is analyzed with respect to claim 2.

Claim 28 is analyzed with respect to claim 3.

Claim 29 is analyzed with respect to claim 4.

Claim 30 is analyzed with respect to claim 5.

Claim 33 is analyzed with respect to claim 18.

Claim 34 is analyzed with respect to claim with claim 9.

Claim 35 is analyzed with respect to claim 7.

Claim 36 is analyzed with respect to claim 1 in which the 1st broadcast stream and the 2nd media are both transmitted from a broadcaster.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (US 2001/0037500).

   Claim 6, Reynolds does not disclose wherein the event includes notification that an e-mail message has arrived.

   Official Notice is taken that notification of an e-mail message to a user is notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Reynolds by including such e-mail notification so to notify user of incoming mail.

   Claim 16 is analyzed with respect to claim 6.

3. Claims 8, 17 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (US 2001/0037500) in view of Bullock et al. (US 5070404).

Claim 8, Reynolds does not disclose using a pilot tone or watermark as priority indicators.

Bullock discloses the use of cue code wherein each cue code comprises four DTMF tones as Indicator (Col. 6, lines 43-Col. 7, lines 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Reynolds with Bullock so to take the advantage of the uniqueness of each cue code for determining the presence of the stored data having an identifier corresponding to the cue signal and for providing an indication to the user of the presence of the stored data (Col. 2, lines 1-6).

Claim 17, limitation "the priority indicators are embedded into the broadcast stream using a pilot tone or watermark" is analyzed with respect to claim 8 and Bullock further discloses wherein the broadcaster my assign a plurality of priority indicators to different segments of a broadcast stream (Col. 6, lines 60-65+).

Claim 32, "the priority indicators are embedded into the broadcast stream using a pilot tone or watermark" is analyzed with respect to claim 8 and Bullock further discloses wherein the broadcaster my assign a plurality of additional priority indicators to different segments of a broadcast stream (Col. 6, lines 60-65+).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht
09/01/2006

HAI TRAN
PRIMARY EXAMINER